

BEST AVAILABLE COPY**REMARKS**

The Examiner rejected claims 1-11 and 20-28 under 35 U.S.C. §112, first paragraph.

The Examiner rejected claims 1-11 and 20-28 under 35 U.S.C. §112, second paragraph.

The Examiner rejected claims 1-4, 7, 27, and 28 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,397,361 to Saitoh.

The Examiner rejected claims 5 and 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over Saitoh in view of U.S. Patent No. 6,262,580 to Wu.

The Examiner objected to claims 8-11 and 20-26 and would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, set forth in the Office action and to include all of the limitations of the base claim and any intervening claims. Accordingly, Applicants have rewritten claim 8 in independent form and the 35 U.S.C. §112, second paragraph rejections are moot as explained *infra*.

Claims 3 and 5 have been rewritten in independent form and the 35 U.S.C. §112, second paragraph rejections are moot as explained *infra*.

Applicants respectfully traverse the §112, §102 and §103 rejections with the following arguments.

35 U.S.C. §112, First Paragraph

The Examiner rejected claims 1-11 and 20-28 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.

The Examiner alleges: "In claim 1, line 3, it is not understandable what is meant by "a control I/O", since there is no clear and specific indications discloses in the Specification".

In response, Applicants respectfully contend that the rejection of claims 1-11 and 20-28 under 35 U.S.C. §112, first paragraph is moot, since claim 1 has been canceled and none of the pending claims include the phrase "control I/O".

35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 1-11 and 20-28 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner alleges: "Regarding claim 1, the phrase "may be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention."

In response, Applicants respectfully contend that the rejection of claims 1-11 and 20-28 under 35 U.S.C. §112, second paragraph is moot, since claim 1 has been canceled and none of the pending claims include the phrase "may be".

35 U.S.C. §102(b)

The Examiner rejected claims 1-4, 7, 27, and 28 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,397,361 to Saitoh.

Since claims 1-2 have been canceled, the rejection of claims 1-2 under 35 U.S.C. §102(b) is moot.

Applicants respectfully contend that Saitoh does not anticipate claim 3, because Saitoh does not teach each and every feature of claim 3. For example, Saitoh does not teach the feature: "triggering a first latch at an initialization of the transition response and triggering a second latch when the transition response has reached a transition threshold value".

The Examiner argues: "With respect to claims 1-4, Saitoh discloses a method of testing a semiconductor chip having a plurality of common I/Os associated therewith whose characteristics or properties can be tested by applying a test signal through a control I/O, the method comprising the steps of: connectivity testing a chip-to-package connection of at least one of the common I/O (see col. 3, lines 37-54 and col. 11, line 51 to col. 13, line 17); and determining whether the chip-to-package connection is faulty from a result of the connectivity testing (see col. 8, line 62 to col. 10, line 25 and col. 13, lines 17-21)."

In response, Applicants maintain that none of the preceding citations to Saitoh by the Examiner teaches the aforementioned feature of claim 3.

Based on the preceding arguments, Applicants respectfully maintain that Saitoh does not anticipate claim 3, and that claim 3 is in condition for allowance. Since claims 4, 7, 27, and 28 depend from claim 3, Applicants contend that claims 4, 7, 27, and 28 are likewise in condition for allowance.

35 U.S.C. §103(a)

The Examiner rejected claims 5 and 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over Saitoh in view of U.S. Patent No. 6,262,580 to Wu.

Applicants respectfully contend that claim 5 is not unpatentable over Saitoh in view of Wu, because Saitoh in view of Wu does not teach or suggest each and every feature of claim. For example, Saitoh does not teach or suggest the feature: "wherein determining whether the chip-to-package connection is faulty comprises: comparing a first RC constant associated with a first signal relating to a connectivity testing of a first I/O with a second RC constant associated with a second signal relating to a connectivity testing of a second I/O".

The Examiner admits that Saitoh does not disclose the preceding feature of claim 5. The Examiner argues: "Wu teaches determining whether the chip-to-package connection is faulty comprises: comparing a first RC constant associated with a first signal relating to a connectivity testing of a first I/O with a second RC constant associated with a second signal relating to a connectivity testing of a second I/O (see col. 2, lines 9-24 and col. 3, line 26 to col. 4, line 65).... It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Saitoh's method to include determining whether the chip-to-package connection is faulty comprises: comparing a first RC constant associated with a first signal relating to a connectivity testing of a first I/O with a second RC constant associated with a second signal relating to a connectivity testing of a second I/O, as taught by Wu, in order to test whether the integrated circuit can function properly."

In response, Applicants maintain that the preceding citation to Wu by the Examiner does not disclose any comparison of a first RC constant with a second RC constant, as required by

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claim 5.

Based on the preceding argument, Applicants respectfully contend that claim 5 is not unpatentable over Saitoh in view of Wu, and that claim 5 is in condition for allowance. Since claim 6 depends from claim 5, Applicants contend that claim 6 is likewise in condition for allowance.

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CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0456.

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